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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/901,662 | 07/11/2001 | Takashi Yamaguchi | 0649-0791P | 7851 |

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EXAMINER

WYROZEBSKI LEE, KATARZYNA I

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1714

DATE MAILED: 04/01/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/901,662

Applicant(s)

YAMAGUCHI ET AL.

Examiner

Katarzyna Wyrozebski Lee

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3 6) ☐ Other:

Claims Analysis

It is noted that claims 1 and 12 are in process-by-product format. According to *In re Thorpe*, 777 F.2d 695, 698 227 USPQ 964, 966 (Fed. Cir. 1985), in such claims determination of patentability is based on the product itself and not on its methods of production, absent showing of criticality of the process steps (See MPEP 2113).

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Gynn (US 5,521,232).

Table in col. 6 of the prior art of Gynn discloses composition comprising unsaturated polyester, peroxide initiator, zinc stearate, calcium carbonate or clay filler and chopped fiberglass. According to the description of the Gynn (col. 4, lines 16-21), the polyester utilized in the examples has acid value of 30. The composition is utilized to make molded parts (col. 5, line 50), which include parts for cars, trucks, boats and the like (col. 5, lines 60-62).

Calcium carbonate utilized in the examples of Table in col. 6, has particle size of 3-8 microns.

Table in col. 6 also discloses following amounts: unsaturated polyester 60 parts by weight (PHR), Calcium Carbonate in amount of 40 phr and glass fibers in amount of 28 phr and peroxide radical generator in total of 1.8 phr.

Zinc stearate is utilized in amount of 4 phr. Since zinc is +2 metal, zinc stearate is therefore divalent salt of fatty acid.

Claim 13 of the prior art of Gym also discloses use of organic fibers such as polyester fiber, polyamide fiber and polyolefin fiber.

In the light of the above disclosure, the prior art of Gynn anticipates requirements of claims rejected above.

3. Claims 1, 4, 10, 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Sugita (US 6,329,442).

Example 12 (col. 17-18) of the prior art of Sugita discloses composition comprising UP1 unsaturated polyester resin, calcium carbonate, glass fiber and radical initiator package were mixed and molded utilizing spray-up molding machine. The UP1 polyester resin of example 12 has acid value of 40 (example 1, col. 14).

Per 100 parts of polyester resin, example 12 utilizes 30 parts of calcium carbonate, 2 parts of silica and 33 % of glass fibers. According to specification, the initiator system is utilized in an amount of 0.05-15 wt % (col. 4, lines 5-10).

In the light of the above disclosure, the prior art of Sugita anticipates requirements of claims rejected above.

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following prior art although applicable against present claims does not qualify as a prior art for date purposes: Aoki (US 6,339,115) and Yamaguchi (US 6,300,387).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski Lee whose telephone number is (703) 306-5875. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


KIWL
March 26, 2003